

REMARKS

After entering the above amendments, claims 1-10 and 15-23 will be pending. Reconsideration and allowance of the current application are requested in light of the above-marked amendments and the foregoing remarks.

Summary of Claim Rejections. The Office has rejected claims 2 and 22 under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the enablement requirement and claims 1-10 and 15-23 under 35 U.S.C. §102(e) as allegedly being unpatentably obvious over U.S. Pre-Grant Publication 2004/0133342 by Banker ("Banker"). While the rejection is not explicitly stated, it appears that the Office also alleges that claims 1-23 are indefinite (and thus presumably rejected under 35 U.S.C. §112, second paragraph due to use of terms such as "can be," "to be capable of," and "may be."

Summary of Amendments. With this amendment, claims 4, 5, 16, 19, and 22 have been amended. The amendments to claims 4, 5, 16, and 19 remove the terms "can be" and "is capable of" to which the Office has objected. Claim 22 has been amended to correct an error in the previous amendment in this matter in which erroneous text was added at the end of the claim as previously presented. no new matter has been added with these amendments.

Improper Rejections Under 35 U.S.C. § 132

As an opening note, Applicant respectfully submits that the pending Office Action in this matter is highly unclear in its content and with regards to which claims are rejected and for what reasons. It is therefore respectfully submitted that the current rejections as stated in the pending Office Action are in violation of 35 U.S.C. § 132 because the explanations the Office provides lack sufficient specificity. The rejections under 35 U.S.C. §102(e) simply restate each pending claim element with an implied statement of rejection. The only references provided are to figure reference numbers and/or to whole paragraphs in the Banker publication. The rejections as stated fail to provide any justification or explanation as to how or why the identified features in Banker allegedly correspond to the recited limitations of the rejected

claims. Simply stating that the various features of the claims as presented are disclosed according to non-specific reference to features shown in figures does not provide sufficient notice to Applicant, nor does it serve to advance prosecution of the current subject matter. Applicant is at a distinct disadvantage in replying to rejections presented in this manner because preparation of a logical rebuttal of the Office's positions regarding how the cited reference allegedly anticipates the claimed subject matter is severely hampered when the Office's position is not clearly stated. Thus, Applicant respectfully submits that the currently pending rejections violate 35 U.S.C. § 132 and are, therefore, improper. Accordingly, Applicant respectfully requests that these rejections be withdrawn. The following remarks are intended to address all of the pending rejections as currently understood.

Rejections under 35 U.S.C. §112, First Paragraph

Claims 2 and 22 stand rejected under 35 U.S.C. §112, first paragraph, because the Office alleges that the claims lack enablement. This rejection is respectfully traversed. The Office has alleged that the instant specification fails to describe the term "different visual configuration" in such a way as to enable one of skill in the art to make and/or use the invention. As a first point, Applicant respectfully questions the basis for this rejection. The term in question has been present in the claims since the filing of the original application, and has been discussed at length in previous responses filed in this matter. Furthermore, the previous four Office Actions in this matter have raised no such objection to the use of this term.

In the interest of furthering prosecution in this matter, Applicant respectfully directs the Office to at least the following passages in the original specification which clearly and concisely explain the meaning of "visual configuration." At page 4, lines 19-22, "visual configurations" are clearly identified as possibly including "the search result being displayed in table form, as a map, as a chart, as a diagram, as a list of information, and other forms of visual data presentation including combinations of the ones mentioned." Further down page 4, at lines 23-25, the specification states that "visual configurations 122 may specify the

characteristics of how they are displayed, such as the number of rows in a table or the size of a chart.”

“Different visual configurations” are discussed at least at page 11, lines 16-18: “the user may select a different visual configuration using the control” and at FIG. 7B and page 12, lines 15-19: “the user is able to try different visual configurations for the data.”

It is respectfully submitted that the specification is not in any way unclear as to the meaning of the term “different visual configurations” as a number of possible examples of visual configurations are described. For at least these reasons, withdrawal of the pending rejection under 35 U.S.C. §112, first paragraph is respectfully requested.

Rejections under 35 U.S.C. §112, Second Paragraph

Claims 1-23 apparently stand rejected under 35 U.S.C. §112, second paragraph, because the Office alleges that the claims fail to clearly delineate the subject matter that the Inventor(s) intend to claim. The Office expresses concern about use of the terms “can be,” “to be capable of,” and “may be” in the claims. This rejection is respectfully traversed.

Claims 4, 5, and 16 have been amended as noted above to remove terms of this nature. The only claims that retain such language are the independent claims 1, 15, 18, and 21. Applicant respectfully submits that the phrases “that a user can select” and “that a user may select” which appear in these claims do not render the claims indefinite, but are rather necessary for the accurate claiming of a control in a user interface that presents a variety of options to a user. The limitations in question are not recited for the capability of performing a step but instead are part of the description of a step or feature that presents a selectable choice to the user. If the Office continues to object to this language as presented, Applicant suggests that the phrase “selectable by a user” can be substituted. However, Applicant does not see any rational distinction between the existing claim language and this alternative. Applicant therefore leaves these claims as previously presented and respectfully requests withdrawal of the pending rejection under 35 U.S.C. §112, second paragraph.

Rejections under 35 U.S.C. §102

Claims 1-10 and 15-23 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Banker. This rejection is respectfully traversed. To present a valid anticipation rejection under 35 U.S.C. §102, the Office must identify a single prior art reference in which “each and every element as set forth in the claim is found, either expressly or inherently described.” MPEP §2131 quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The rejection over Banker fails to satisfy this burden with regards to the currently pending claims.

Banker discloses a linked information system that employs evolutionary media content links. A media content distribution system as disclosed by Banker can include selected media content accessible to remotely located users in an electronic format over a computer network. Media content can be selected during the course of a human analysis based on relevance to tracked topics. Banker does not in any way disclose or suggest the use of a control that is displayed in a user interface wherein the control presents two or more selectable, predetermined search options that can or may be selected by a user for execution and wherein each of the search options specifies and displays both a) an associated predetermined query to be performed on a data repository and b) an associated visual configuration for displaying results of the predetermined query

With regards to claims 1, 15, 18, and 21, the Office first alleges that Banker illustrates displaying a control in a computer use interface at FIG. 4, 400A.¹ The Office has provided no explanation of its allegation that the keyboard 400A of Banker anticipates the claim term “displaying a control in a computer user interface.” Applicant surmises that the office alleges that the keyboard is a user interface. While such a position is accurate in general, it is not in any way consistent with the terms as used in the rejected claims or even with the remainder of the rejections of these claims as stated by the Office. The Office’s statement of the rejections of claims 1, 15, 18, and 21 continues from the bottom of page 3 to the top of

¹ Applicant notes that FIG. 1 does not include a reference number 400A. However, FIG. 4 does include 400A, which is described in paragraph [0695] as a “keyboard 400A.”

page 4 of the current Office Action with an allegation that the claimed phrase “the control presenting a plurality of selectable, predetermined search options that a user can select for execution, each search option specifying and displaying in the control both an associated predetermined query to be performed on a data repository and an associated predetermined visual configuration for displaying a result of the predetermined query” is disclosed at FIG. 4, reference numerals 422 and 418.² While the keyboard 400A of Banker provides a data entry interface via which a user can input commands, it does not in any way present a plurality of selectable, predetermined search options that a user can select for execution. Furthermore, the Office apparently alleges (although again, no explanation of the rejection is provided) that the “markup palette 422” of Banker in some way represents some aspect of the claimed control that present a plurality of selectable options that each specifies and displays in the control a) an associated predetermined query and b) an associated visual configuration for displaying a result of the predetermined query. The markup palette 422 of Banker rather merely presents a user with choices of type of mark-up tool that can be selected. No query (predetermined or otherwise) is associated with any of these options and neither is a visual configuration in which the results of the query are to be presented.

The Office then alleges that paragraph [0705] of Banker discloses performing the predetermined data repository query associated with the selected predetermined search and displaying the result of the predetermined query using the predetermined visual configuration associated with the selected search option. Paragraph [0705] of Banker reads as follows:

[0705] Referring to FIG. 6, the media content distribution system according to the present invention is able to respond to user input in the form of a topic selection 600 by communicating the topic selection to a search and retrieval module 602. In turn, search and retrieval module 602 is able to search the existing cite objects 428 and return as at 604 any cite objects 428 relevant to topic five. For example, consider the case where a first cite object's topics table object indicates that it is relevant to topic five with a

² Again, FIG. 1 does not include the cited reference numerals, which appear only in FIG. 4. Paragraph [0698] discusses a markup palette 422 in regards to FIG. 4. FIG. 4 includes reference numeral 418, which is not described or referenced in the Banker specification. Applicant's remarks are based on the assumption that the Office intended to reference FIG. 4 in this rejection.

relevance score of nine, and a second cite object's topics table object indicates that it is relevant to topic five with a relevance score of four. Also, assume that a higher relevance score indicates a higher level of importance. In this case, search and retrieval module 602 compares the relevance scores and returns the first cite object and the second cite object in an order according to their respective relevance as at 428A. Additionally, search and retrieval module 602 notes those markup overlay files among mark up files 427A that are associated with the first and second cites' relevance to topic five and returns the indicated markup overlay files 427A1 in association with the associated cites of the returned cites 428A.

Applicant respectfully requests that the Office more clearly identify where in this paragraph or anywhere else in the specification or figures of Banker is disclosed the explicitly recited claim limitations pertaining to performance of a predetermined data repository query that is associated with a predetermined search option and where the result of that predetermined query is displayed using the predetermined visual configuration associated with the selected search option. Paragraph [0705] of Banker discloses only that a topic selection is communicated to a search and retrieval module 602 and that search and retrieval module 603 performs a search and returns results. No disclosure or suggestion is provided in regards to the explicit limitations of claims 1, 15, 18, and 21 regarding the association in a single search option of a predetermined query and a predetermined visual configuration in which to display the results of that predetermined query. For further clarification in this issue, Applicant respectfully refers the Office to the previous official correspondence in this matter which demonstrates that the Office and the Applicant had agreed on the meaning of these terms and their clear distinction over the prior art then of record. Based on Applicant's careful reading of the totality of the Baker disclosure, it is respectfully submitted that Banker is a substantially less relevant reference than the previously considered and overcome art in this presented by the Office in this matter.

With regards to claim 2, the Office alleges that reference number 426 in FIG. 4 discloses two of the predetermined search options that specify a common predetermined visual configuration specify different predetermined queries. Applicant respectfully disagrees with this allegation on several grounds. First, "topic selection window 426" of Banker as described at paragraphs [0700] to [0701]. The

description of this “topic selection window 426” clearly indicates that it is not a control that presents options for selecting predetermined queries and predetermined visual configurations in which the results of the predetermined queries are to be displayed but rather a means for specifying “a degree of relevance (importance) in the form of a relevance score...for comparing relevance of the displayed media selection relating to the specified topic to other media content also relevant to the specified topic and having a relevance score” (see paragraph [0701]). In other words, the “topic selection window 426” is nothing more than a means for assigning a relevance score to an image or other media content. No queries or searches are entered via the “topic selection window 426,” and thus the “topic selection window 426” can not in any way be reasonably argued to present predetermined search options that each present associated predetermined queries to be performed on a data repository and associated predetermined visual configurations in which to display the associated predetermined query results.

In closing, Applicant reiterates that the rejections as currently stated fail to comply with even the minimum standards of 35 U.S.C. § 132. Where possible, Applicant has attempted to rebut the apparent substance of the rejections as stated. however, Applicant respectfully urges the Office to withdrawn these rejections both due to their lack of clarity and the general failure of banker to anticipate numerous explicit limitations of the independent claims. For at least these reasons, withdrawal of the pending rejection under 35 U.S.C. §102 is respectfully requested.


CONCLUDING COMMENTS

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

On the basis of the foregoing amendments, it is respectfully submitted that the pending claims are in condition for allowance. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below. No fees are believed to be due, however the Commissioner is hereby authorized to charge any fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 34874-021/2003P00725US.

Respectfully submitted,

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